

REMARKS

Claim 1 has been amended to obviate the §112 rejections and to better define and distinguish the invention from the prior art. Claims 5 and 6 have been amended to better define the invention. The Specification has been amended to correct typographical errors. No new matter has been added by the aforementioned changes.

The Examiner's rejection of claims 8 and 9 under 35 USC §112 is improper. Claims 8 and 9 are valid product-by-process claims. Product-by-process claims are common and do not inherently conflict with the second paragraph of 35 USC §112. *In re Steppan*, 55 CCPA 791, 394 F.2d 1013, 156 USPQ 143 (1967). For example, in the *In re Thorpe* case, the Federal Circuit has stated that the product-by-process claim "The product of the process of Claim 1" is a valid claim (777 F.2d 695, 227 USPQ 964, (Fed. Cir. 1985)). It is submitted Applicant's claims 8 and 9 are allowable product-by-process claims and analogous to the product-by-process claim in the *In re Thorpe* case, and thus the rejection should be withdrawn.

Turning to the art rejections, the rejection of claims 1-7 and 8-9 under 35 USC §102(a) as being anticipated by Wong et al. (U.S. Patent No. 5,869,196) is in error.

Wong et al. describes a process for making superconducting material where a rolling method is used to obtain thinner foil. However, handling of this highly aspected thin foil is difficult after leaching. The present invention addresses this problem by changing the billet design, providing structural support in order to achieve the optimal aspect ratio with the thinnest foil. In place of a uniform array of rods as shown in FIG. 1a of Wong et al., independent claim 1, as amended, requires, in part, cutting the elongated elements from step b) and forming the cut elements into a stack around a metal core; surrounding the stack of cut elements with a porous confining layer to form a secondary billet; and working the secondary

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billet through a series of reduction steps including twisting and rolling into thin ribbon having an Aspect Ratio of greater than 5:1 prior to cutting the worked billet and then leaching the core and sheaf. Wong does not teach this. All that Wong teaches is an aspect ratio greater than or equal to 2 (col. 15, lines 32-34). Nor would reduction to an aspect ratio greater than 5 be obvious or, as the Examiner claims, "inherent" in Wong, particularly when one considers the technical problem of handling thin foils, particularly after leaching (see specification, p. 10, line 12).

Moreover, this distinction is more than merely academic and provides Applicant with advantages in terms of both leaching and handling of the highly compacted material. Thus, neither claim 1 nor any of the claims dependent thereon can be said to be anticipated by or for that matter obvious from Wong.

New claims 10 to 12 have added to further scope the invention, and are allowable for the same reasons above adduced relative to claim 1, as well as for their own additional limitations.

Having dealt with all the objections raised by the Examiner, the Application is believed to be in order for allowance. Early and favorable action is respectfully requested.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account Number 08-1391.

Respectfully submitted,



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